

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed February 6, 2006. Upon entry of the amendments in this response, claims 21 – 38 remain pending. In particular, Applicants amend claims 21, 28, and 33. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

I. Rejections Under 35 U.S.C. §102

A. Claim 21 is Allowable Over *Marsh*

The Office Action indicates that claim 21 stands rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent Number 6,931,657 ("*Marsh*"). Applicants respectfully traverse this rejection on the grounds that *Marsh* does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 21 recites:

A selectable recording device for providing recording options to record a least a portion of a particular program, the particular program including a plurality of content streams, the device comprising:

a storage device configured to store program information received from an input source, wherein the program information includes a plurality of content streams for a plurality of program events; and
a processor configured to:

provide a user option to ***select a desired subset of the plurality of content streams for the particular program event for recording, wherein the subset excludes at least one available content stream from the program event***; and

receive user input indicating the desired subset of content streams from the program event for recording.

(emphasis added)

Applicants respectfully submit that claim 21, as amended, is allowable for at least the reason that the cited art does not disclose, teach, or suggest a "selectable recording device for providing recording options to record a least a portion of a particular program, the particular program including a plurality of content streams, the device comprising... a processor configured to... provide a user option to ***select a desired subset of the plurality of content streams for the particular program event for recording, wherein the subset excludes at***

least one available content stream from the program event” as recited in claim 21, as amended. More specifically, *Marsh* appears to disclose “the viewer may configure intelligent content agent 108 to expressly include or exclude certain channels and/or certain programs by any identifiable characteristic (content) that can be found in the EPG database” (column 5, line 50). Applicants respectfully submit that this is different than “provid[ing] a user option to ***select a desired subset of the plurality of content streams for the particular program event for recording, wherein the subset excludes at least one available content stream from the program event***” as recited in claim 21, as amended. For at least this reason, claim 21, as amended is allowable over the cited art.

B. Claim 28 is Allowable Over *Marsh*

The Office Action indicates that claim 28 stands rejected under 35 U.S.C. §102(e) as allegedly being anticipated by *Marsh*. Applicants respectfully traverse this rejection on the grounds that *Marsh* does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 28 recites:

A method for providing recording options to a user, comprising:
receiving program information, wherein the program information includes a plurality of content streams for at least one of a plurality of program events;
providing a user option ***to select a desired subset of content streams for a particular program event for recording***, wherein the subset ***excludes at least one available content stream from the program event***; and
receiving user input indicating the desired subset of content streams from the program event for recording.

(emphasis added)

Applicants respectfully submit that claim 28, as amended, is allowable for at least the reason that the cited art does not disclose, teach, or suggest a “method for providing recording options to a user, comprising... providing a user option ***to select a desired subset of content streams for a particular program event for recording***, wherein the subset ***excludes at least***

one available content stream from the program event" as recited in claim 28, as amended. More specifically, *Marsh* appears to disclose "the viewer may configure intelligent content agent 108 to expressly include or exclude certain channels and/or certain programs by any identifiable characteristic (content) that can be found in the EPG database" (column 5, line 50). Applicants respectfully submit that this is different than "providing a user option **to select a desired subset of content streams for a particular program event for recording**, wherein the subset **excludes at least one available content stream from the program event**" as recited in claim 28, as amended. For at least this reason, claim 28, as amended is allowable over the cited art.

C. Claim 33 is Allowable Over *Marsh*

The Office Action indicates that claim 33 stands rejected under 35 U.S.C. §102(e) as allegedly being anticipated by *Marsh*. Applicants respectfully traverse this rejection on the grounds that *Marsh* does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 33 recites:

A system for providing recording options to a user, comprising:
a receiver configured to receive program information from an input source, the program information including a plurality of content streams for a at least one of a plurality of program events; and
a control system configured to:
provide a user option to **select a desired subset of the plurality of content streams for a particular program event of the plurality of program events**, wherein the subset **excludes at least one available content stream from the program event**; and
receive a user command indicating the desired subset of content streams from the program event for recording.

(emphasis added)

Applicants respectfully submit that claim 33, as amended, is allowable for at least the reason that the cited art does not disclose, teach, or suggest a "system for providing recording options to a user, comprising... a control system configured to... provide a user option to **select a desired subset of the plurality of content streams for a particular program event of the**

plurality of program events, wherein the subset **excludes at least one available content stream from the program event**” as recited in claim 33, as amended. More specifically, *Marsh* appears to disclose “the viewer may configure intelligent content agent 108 to expressly include or exclude certain channels and/or certain programs by any identifiable characteristic (content) that can be found in the EPG database” (column 5, line 50). Applicants respectfully submit that this is different than “provid[ing] a user option to **select a desired subset of the plurality of content streams for a particular program event of the plurality of program events**, wherein the subset **excludes at least one available content stream from the program event**” as recited in claim 33, as amended. For at least this reason, claim 33, as amended is allowable over the cited art.

B. Claims 22 – 27, 29 – 32, 34 – 35, and 38 are Allowable Over Marsh

The Office Action indicates that claims 22 – 27, 29 – 32, 34 – 35, and 38 stands rejected under 35 U.S.C. §102(e) as allegedly being anticipated by *Marsh*. Applicants respectfully traverse this rejection on the grounds that *Marsh* does not disclose, teach, or suggest all of the claimed elements. More specifically, dependent claims 22 – 27 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 21. Dependent claims 29 – 32 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 33. Dependent claims 34 – 35 and 37 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 33. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

II. Claims 36 and 37 are Allowable Over Marsh in view of Hoffberg

The Office Action indicates that claims 36 and 37 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Marsh* in view of U.S. Patent Number 6,418,424 (“*Hoffberg*”).

Applicants respectfully traverse this rejection for at least the reason that *Marsh* in view of *Hoffberg* fails to disclose, teach, or suggest all of the elements of claims 36 and 37. More specifically, dependent claims 36 and 37 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 33. *In re Fine, Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

III. Alleged Inherency

A. The Subject Matter of Claims 24 and 31 is Not Inherent

In addition, the Office Action asserts that “[i]n regard to claims 24 and 31, Marsh discloses a decryption device... the set top box has a capability to decrypt viewer profile information and other information as the STB interfaces with media system 100, which also inherently suggests decryption of scrambled programming” (OA page 3, last paragraph). Applicants respectfully traverse the finding of inherency. It is well established that “[t]o establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In Re Anthony J. Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2D (BNA) 1949, 1950-51 (Fed. Cir. 1999).

Applicants respectfully submit that the Office Action fails to adequately establish that the subject matter of claims 24 and 31 is necessarily present. As the Office Action fails to provide any extrinsic evidence that makes clear that the missing descriptive matter is necessarily present, Applicants respectfully submit that inherency has not been established. In accordance with *In re Robertson*, Applicants traverse the inherency finding, and submit that claims 24 and 31 are allowable over the cited art.

B. The Subject Matter of Claim 27 is Not Inherent

In addition, the Office Action asserts that “[i]n regard to claim 27, Marsh inherently teaches at least one decoder configured to decode at least one content stream” (OA page 4, paragraph 3). Applicants respectfully traverse the finding of inherency. It is well established that “[t]o establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In Re Anthony J. Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2D (BNA) 1949, 1950-51 (Fed. Cir. 1999).

Applicants respectfully submit that the Office Action fails to adequately establish that the subject matter of claim 27 is necessarily present. As the Office Action fails to provide any extrinsic evidence that makes clear that the missing descriptive matter is necessarily present, Applicants respectfully submit that inherency has not been established. In accordance with *In re Robertson*, Applicants traverse the inherency finding, and submit that claim 27 is allowable over the cited art.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and Official Notice, or statements interpreted similarly, should not be considered well-known for the particular and specific reasons that the claimed combinations are too complex to support such conclusions and because the Office Action does not include specific findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

/ afb /
Anthony F. Bonner Jr. Reg. No. 55,012

**THOMAS, KAYDEN,
HORSTEMEYER & RISLEY, L.L.P.**
Suite 1750
100 Galleria Parkway N.W.
Atlanta, Georgia 30339
(770) 933-9500